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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/663,320	09/16/2003	Matthew B. Buczek	13DV-13124 (07783-0149-2)	1327
31450	7590	11/27/2006	EXAMINER	
MCNEES WALLACE & NURICK LLC 100 PINE STREET P.O. BOX 1166 HARRISBURG, PA 17108-1166			JOLLEY, KIRSTEN	
			ART UNIT	PAPER NUMBER
			1762	

DATE MAILED: 11/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

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Advisory Action Before the Filing of an Appeal Brief	Application No. 10/663,320	Applicant(s) BUCZEK ET AL.	
	Examiner Kirsten C. Jolley	Art Unit 1762	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 November 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).


4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 17-19,21-23,26-28,30-32,34,36,38,and 39.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☒ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached action.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____.
13. ☐ Other: _____.


Kirsten C Jolley
Primary Examiner
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ADVISORY ACTION

1. Applicant's arguments and the 37 CFR 1.132 Declaration filed November 3, 2006 have been considered, but do not place the case in condition for allowance.

Applicant argues that there is no indication in the specification or the figures indicating that the figures do not represent the present invention and the Examiner has not pointed to any evidence establishing that the figures do not represent the present invention. Applicant also states that merely stating that the figures are schematic is insufficient to establish that the claims are non-enabled. The Examiner disagrees. As discussed in the prior Office action, there is no teaching how to make the claimed invention, specifically how to make and maintain the particles physically separated from one another. While the drawings illustrate physical separation, there must be some teaching to guide one of ordinary skill in the art how to make the invention, i.e., how to provide physical separation between particles. The drawings do not provide such a teaching. In a typical fluid medium containing non-spherical metal particles, at least some of the particles would be touching or abutting since the particles are randomly mixed in the fluid.

Applicant argues and states in the Declaration filed November 3, 2006 that an oxide layer, more specifically an aluminum oxide layer, provides a barrier layer and prevents particle-to-particle contact while allowing movement of the individual particles within the medium. Applicant further argues that a few of the exemplary particles listed in the specification would contain aluminum and thus necessarily have oxide layers thereon. The Examiner first notes that there is no mention of a barrier layer existing on the particles in the specification. To the contrary, the specification discloses at page 6, lines 7-9, that the particles can have a core of a

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metal based on Fe, Ni, Co or their alloys. The disclosure would not have guided one having ordinary skill in the art to have only selected particles containing aluminum in order to achieve the claimed invention - such is not disclosed or even suggested by the specification. Further, the claims are not commensurate in scope with Applicant's arguments/Declaration. The claims do not require the presence of a barrier layer, or even the inclusion of aluminum in the metal particles. The claims are broadly directed to the use of any non-spherical metal particles in combination with any non-metallic medium. It remains the Examiner's position that not every combination of a non-metallic medium having non-spherical metal particles therein would result in a fluid condition where the particles are all physically separated from one another.


Additionally, it is noted that the Figures illustrate *complete separation* of particles, not particles abutting each other separated only by their respective naturally-occurring oxide barrier layers. Thus the existence of naturally-occurring oxide barrier layers on aluminum-containing particles still does not provide enablement to one of ordinary skill in the art for what is illustrated in the Figures and relied upon for support of the rejected claim limitations.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kirsten C. Jolley whose telephone number is 571-272-1421. The examiner can normally be reached on Monday to Wednesday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571-272-1423. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Kirsten C Jolley
Primary Examiner
Art Unit 1762

kcj